



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,090	07/15/2002	Guillaume Desurmont	6680-010	4942

7590 06/04/2003

Joseph Levi  
Clifford Chance Rogers & Wells  
200 Park Avenue  
New York, NY 10016

EXAMINER
----------

ASINOVSKY, OLGA

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 06/04/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 13

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/937,090	DESURMONT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Olga Asinovsky	1711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
           Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
           If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☒ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
         \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 26-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-9 of U.S. Patent No. 5,698,634. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of Patent 5,698,634 discloses a process for preparing a block copolymer of an alpha-olefin having 3 or more carbon atoms using a trivalent rare earth metal complex, and then polymerizing a vinyl compound or a lactone to said alpha-olefin polymer in claim 1 in Patent 5,698,634. A block copolymer produced by polymerizing of an alpha-olefin=first monomer, and then polymerizing a vinyl compound such as an unsaturated carboxylic acid. The first step of the polymerization of an alpha-olefin=first monomer can produce isotactic block, since a first block comprising polymerizing an alpha-olefin in claim 1 in the Patent' 634 is generic. Any forms of polyolefins can be produced in the first step in claim 1 in the Patent'634. The metal

Art Unit: 1711

complex of the formula (3) in claim 1 in the Patent' 634 is readable in the present claims. Because, the group  $>Ln-CH_4$  would generate the anion  $H^-$  in the catalyst having formula (3) in claim 1 in the Patent '634. A block copolymer produced by polymerizing of an alpha-olefin in the first block, and then polymerizing a vinyl compound or a lactone to said alpha-olefin polymer in claim 1 in the Patent '634 is within the scope in the present claims. The difference is that Patent'634 does not call a catalyst of the formula (3) in the claim 1 in Patent'634 as a hydride complex. However, it would have been obvious to one of ordinary skill in the art to use a process for producing a block copolymer in claims 1-9 in the Patent'634 by using a metal complex of the formula (3) in the claim 1 in the Patent'634 and to consider that a said catalyst is working equally well within the same expectation for being a metal complex catalyst for preparing a block copolymer since the active donor (Donor)<sub>n</sub> that is derived from the group consisting of a ketone, an ester, an ether and an amine is also generating the anion  $H^-$ .

### ***Response to Arguments***

2. Applicant's arguments filed 05/05/03 have been fully considered but they are not persuasive. Applicants argue that the claims 1-9 in the Patent 5,698,634 do not recite a "first, isotactic block".

Art Unit: 1711

A first block comprising polymerizing an alpha-olefin in claim 1 in the Patent' 634 is generic. Therefore, any forms of polyolefins can be produced in the first step in claim 1 in the Patent'634.

Also, applicants' argument is that the claims 1-9 in the Patent 5,698,634 does not disclose a catalyst in the form of "a hydride complex of a trivalent metal from the rare earth group" (having the indicated formula), as recited in the present claim 26.

The metal complex of the formula (3) in claim 1 in the Patent' 634 is readable in the present claims. Because, the group  $>Ln-CH_4$  would generate the anion  $H^-$  in the catalyst having formula (3) in claim 1 in the Patent '634. The active donor (Donor)<sub>n</sub> that is derived from the group consisting of a ketone, an ester, an ether and an amine is also generating the anion  $H^-$ . It is a burden on the applicants to present the evidence that the "hydride complex of a trivalent metal from the rare earth group" in the present invention works different from the catalyst of the formula (3) in the claim 1 in the Patent 5,698,634.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 1711

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The references cited in the Search Report PCT/FR00/00614 have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within the set period for reply to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 703-308-0041. The examiner can normally be reached on 9:00 to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Art Unit: 1711

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

O.A.

O.A.

June 2, 2003

Olga Asinovsky  
Examiner  
Art Unit 1711



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700